

REMARKS

This is a full and timely response to the Office Action mailed April 19, 2005, submitted concurrently with a one month extension of time to extend the due date for response to August 19, 2005.

No claims have been amended in this response. Thus, claims 4-18 remain pending in this application.

In view of this response, Applicants believe that all pending claims are in condition for allowance. Reexamination and reconsideration in light of the following remarks are respectfully requested.

Rejection under 35 U.S.C. §103

Claims 4-18 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Nelson (WO 96-22686) in view of Burke (U.S. Patent 5,620,678), Hibbard (U.S. Patent 2,803,581) and Dohara et al. (U.S Patent 5,055,299). Applicant respectfully traverses this rejection.

The Examiner argues that Applicant's claim is to a single phase but this limitation is only in the preamble and is thus not given patentable weight. Applicant strongly disagrees with the Examiner in this regard. According to §2111.02 of the Manual of Patent Examining Procedure, the preamble is not given the effect of a limitation "unless it breathes life and meaning into the claim". In other words, in order to limit the claim, the preamble must be "*essential to point out the invention defined by the claim.*" *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Under U.S. case law, any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation. See, e.g., *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257, 9 USPQ2d 1962, 1966 (Fed. Cir. 1989). For example, in *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951), a preamble reciting "An abrasive article" was deemed essential to point out the invention defined by claims to an article comprising abrasive grains and a hardened binder and the process of making it. The court said that "*it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. Every union of substances capable inter alia of use as abrasive grains and a binder is not an 'abrasive article.'*"*Id.* at 481, 187 F.2d at 152.

Therefore, the preamble served to further define the structure of the article produced. Also, in *In re Stencil*, 828 F.2d 751, 4 USPQ2d 1071 (Fed. Cir. 1987), the claim was directed to a driver for setting a joint of a threaded collar. The claim did not directly include the structure of the collar as part of the claimed article. The preamble did set forth the structure of the collar but the Examiner had not given this recitation any weight. The court found that the collar structure could not be ignored. While the claim was not directly limited to the collar, the collar structure recited in the preamble did limit the structure of the driver. The court stated that “*the framework - the teachings of the prior art - against which patentability is measured is not all drivers broadly, but drivers suitable for use in combination with this collar, for the claims are so limited.*” Id. at 1073, 828 F.2d at 754.

Here, in this case, the “*single phase aerosol*” limitation clearly breathes life and meaning into the claim and is essential in pointing out the invention defined by the claim *since it clearly limits the structure of the claimed composition*. The Examiner argues that the “*single phase is seen to be claimed as (a) concentrate, separate from (b) propellant*”. However, Applicant does not agree with such an interpretation since the claims clearly recite a “*single phase propellant-concentrate aerosol composition . . . , consisting essentially of a first component (a) and a second component (b)*” which can only be interpreted as the first component (a) (i.e. concentrate) being present together with the second component (b) (i.e. propellant) in a *single phase propellant-concentrate aerosol*. There is no limitation in the claims which indicates that the (a) concentrate is separate from (b) propellant or allows the Examiner to make such an interpretation.

Further, based on knowledge well known to one skilled in the art, emulsions are not equivalent to single phase compositions and thus, cannot be interpreted by the Examiner to constitute a single phase. The aerosol composition of the present application consists essentially of components (a) and (b) (i.e. concentrate and propellant) which together forms a single phase liquid and not an emulsion. The Examiner’s arguments that the single phase can only be seen to be claimed as a concentrate, separate from the propellant and that Nelson’s emulsions constitute a single phase from which separation then occurs, runs contrary to that which is recited in the claims and to what is well known to one skilled in the art.

To clarify the Examiner’s understanding in this regard, Applicant has explained in more detail and with more particularity the differences between the single phase aerosol composition of the present invention and the emulsion aerosol composition of Nelson. In

single-phase aerosol compositions, oleophilic liquid combination and the hydrophilic liquid combination dissolve with each other with the existence of dimethyl ether while, in emulsion aerosol compositions, oleophilic liquid or the hydrophilic liquid is only dispersed in the solvent, Applicant wishes to stress that the claimed dimethyl ether serves as an emulsion breaker by dissolving both with the hydrophilic liquid and the oleophilic liquid to form the single-phase liquid of claims 4, 11 and 16.

It is important to emphasize that Nelson teach that water is present in the composition in an amount of from about 30% to about 70% and preferably from about 40% to about 70% by weight, based on the total weight of the composition (see page 7, lines 19-21, of Nelson). This clearly indicates that Nelson intends to form an emulsion and not a single phase liquid since water, present at higher percentages by weight, forms only an emulsion. As stated on page 7, lines 16-18, of Nelson, “[T]he water forming the aqueous phase of the composition of the invention should be present in an amount effective to form an oil-out emulsion of limited stability and to facilitate spraying”. Thus, Nelson clearly teaches away from the single phase aerosol composition of the present invention.

Under U.S. case law, a prior art reference that "teaches away" from the claimed invention is a significant factor to be considered in determining obviousness. In other words, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). It should also be noted that if a proposed modification (i.e. *use a lower amount of water 30% or less*) would render the prior art invention being modified unsatisfactory for its intended purpose (i.e. *an oil-out emulsion*), then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

In support of our arguments, Applicant has submitted herewith a facsimile copy of the executed Rule 1.132 Declaration showing clearly the differences between the single phase aerosol composition of the present invention and the emulsion aerosol composition of Nelson. Please note that Applicant has also submitted the original copy of the unexecuted Rule 1.132 Declaration since the Figure and pictures in the Declaration can be seen more clearly.

In the Declaration, Figures 1-3 show the aerosol compositions (samples 1- 3) that Applicant has prepared. From this experiment, it is clear that the aerosol composition (sample 1) of the present application forming a single-phase liquid (see Fig. 1C) is different from the aerosol composition (sample 2) of Nelson forming an emulsion (see Fig. 2C). Further, in sample

3, Applicant has prepared an aerosol composition based on the ingredients (i.e. 30 wt % of water, charged with dimethyl ether as a propellant) disclosed in Nelson (see Fig. 3C). Sample 3 has been prepared in response to the Examiner's arguments (see page 2, line 12-14, of the Office action), where dimethyl ether is added in Nelson as a propellant to the concentrate. However, as shown in Figs. 3(A)-3(C), the aerosol composition of sample 3 does not form a single-phase but a double-phase (see, in particular, Fig. 3C).

Figures 4-9 show the details regarding sprayed particles of samples 1-3. From this experiment, the sprayed particles of the present application (sample 1) diffuse longer in the atmosphere due to its small average diameter. This, in turn, means that the aerosol composition forming a single-phase solution has a longer effect than the aerosol composition forming an emulsion or double phase.

Thus, for these reasons, withdrawal of the present rejection is respectfully requested.

CONCLUSION

For the foregoing reasons, all the claims now pending in the present application are believed to be clearly patentable over the outstanding rejections. Accordingly, favorable reconsideration of the claims in light of the above remarks is courteously solicited. If the Examiner has any comments or suggestions that could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the below-listed number.

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Respectfully submitted,

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